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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID T. SHUPING, WILLIAM R. JOHNSON,
and ROBERT C. RANDA

Appeal 2008-0394
Application 10/007,207
Technology Center 2100

Decided: February 5, 2008

Before JAMES D. THOMAS, LANCE LEONARD BARRY, and
JAY P. LUCAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-11, 14-28, 39, 40, 43-58, and 61- 64. (Ans. 3.) The Appellants appeal therefrom under 35 U.S.C. § 134(a). An oral hearing was held on January 23, 2008. We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

1 The invention at issue on appeal is a web browser. Often called the "World Wide Web," the Internet provides a user with a host of "web pages." (Spec. 1.) "Web browsing" refers to the actions of selecting a web page, retrieving data associated therewith, rendering the data, and displaying the web page. (*Id.* 2.)

The Appellants complain that conventional web browsers typically display only one web page at a time. (*Id.*) In contrast, their invention displays a current web page along with past and future web pages. (*Id.* 1.)

B. ILLUSTRATIVE CLAIMS

Claims 1, 4, and 20, which further illustrate the invention, follow.

1. A method for browsing web pages comprising:

receiving first web page data including a plurality of references, each of said plurality of references associated with web page data;

receiving indicia specifying a subset of said plurality of references;

rendering a first web page using said first web page data in a first panel;

automatically requesting web page data associated with said subset of said plurality of references; and

rendering additional web pages using said requested web page data in a second panel.

4. The method of claim 1, wherein said receiving indicia specifying a subset of said plurality of references comprises receiving said indicia as a prioritized list of references in said first web page data.

20. A method for browsing web pages comprising:

- rendering, in a first panel, a current web page from current web page data;

- receiving a reference to a first web page;

- in response to said receiving said reference, requesting first web page data using said reference;

- receiving said first web page data; and

- rendering said first web page in a second panel;

- wherein said first panel and said second panel are contemporaneously viewable by a user.

C. REJECTIONS

Claims 1-3, 20, 21, 26-28, 39, and 40 stand rejected under the judicially-created doctrine of double patenting over claims 1-41 of U.S. Patent No. 6,313,855. Claims 1-3, 20, 21, 26-28, 39, 40, and 47-53 stand provisionally rejected under the judicially-created doctrine of double patenting over claim 1-68 of U.S. Patent Application No. 09/985,415. Claim 46 stands rejected under 35 U.S.C. § 112, ¶ 2 as indefinite.

Claims 1, 3, 6, 9-11, 14-16, 20, 21, 26-28, 43-45, 47-52, 54-58, 61, and 62 stand rejected under 35 U.S.C. § 103(a) as obvious over International Publication WO 97/29414 ("AT&T") and U.S. Patent No. 6,133,916 ("Bukaszar"). Claims 17-19 stand rejected under § 103(a) as obvious over AT&T; Bukaszar; and U.S. Patent No. 5,838,326 ("Card"). Claims 4, 5, 7, 8, 22-25, 63, and 64 stand rejected under § 103(a) as obvious over AT&T; Bukaszar; and U.S. Patent No. 6,433,795 ("MacNaughton").

II. DOUBLE PATENTING AND INDEFINITNESS REJECTIONS OF CLAIMS 1-3, 20, 21, 26-28, 39, 40, AND 46-53

The Appellants do not contest "these rejections in the Appeal Brief." (Br. 8.) Therefore, we summarily affirm the double patenting rejection of claims 1-3, 20, 21, 26-28, 39, and 40; the provisional double patenting rejection of claims 1-3, 20, 21, 26-28, 39, 40, and 47-53; and the indefiniteness rejection of claim 46.

III. OBVIOUSNESS REJECTIONS OF CLAIMS 1, 3, 6, 9-11, 14-19, 43-45, 47-52, 54-58, 61, AND 62

"Rather than reiterate the positions of parties *in toto*, we focus on the issues therebetween." *Ex parte Katsukawa*, No. 2007-0732, 2007 WL 3043602 at *2 (BPAI 2007).

A. TEACHING AWAY

The Examiner makes the following finding and conclusion.

[I]t would have been obvious to a person having ordinary skill in the art at the time of appellant's invention to modify the web browser and montage arrangement of AT & T, where linked "web page" imagery is jointly displayed with the original page having the links, to use the graphical representation of an entire "web page" as per Bukszar's graphical representation of page, the motivation being to create a fuller and more readily -appreciated and - useful representation in the browser view of

the overall context of history that is produced in the AT & T
linked page view.

(Ans. 7.) In what their attorney characterized as their "key argument" during the oral hearing, the Appellants argue that "one of ordinary skill in the art would not be motivated to combine AT&T with a reference such as Bukszar, that teaches rendering all the web page data - not just the image data - because AT&T clearly **teaches away from such a combination.**" (Br. 11.) During an oral hearing, the Appellants characterized this argument as their "key argument." Therefore, the issue is whether the Appellants have shown that AT&T teaches away from combining teachings of Bukszar therewith.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir.1994). Teaching an alternative or equivalent method, however, does not teach away from the use of a claimed method. *In re Dunn*, 349 F.2d 433, 438 (CCPA 1965). To coin a phrase, "teaching a way is not teaching away." See "Teaching a Way is not Teaching Away," 79 J. Pat. & Trademark Off. Soc'y 867 (1997).

Here, the premise of the Appellants' argument is that "[w]hen read as a whole, AT&T apparently teaches that during browsing, it is desirable to render just the images from the multiple web pages rather than to render the

web pages themselves." (Br. 10.) To support that premise the Appellants rely on the reference's identification of "a problem with conventional web browsing" (*Id.* 9.) More specifically, AT&T complains that "accessing web pages with interesting inlined images typically involves browsing through web pages of material by clicking on hypertext links. Although browsing in this way is often rewarding, it requires a good deal of attention on the part of the person who is browsing and can be burdensome." (P. 1, ll. 20-26.)

We are unpersuaded that the problem identified by the reference comprises "rendering all the web page data - not just the image data" (Br. 10.) To the contrary, the problem focuses on the "way" (AT&T, p. 1, l. 23) in which conventional browsing is done, viz., a user manually "click[s] on hypertext links." (*Id.* ll. 22-23.) AT&T solves the problem by what the Appellants' attorney termed automated "forward crawling" during the hearing. Although AT&T happens to forward crawl to just images from web pages (Abs. l. 1), the reference would not have actively discouraged a person of ordinary skill from forward crawling to entire web pages. Instead, we view AT&T's rendering of an image from a web page as a mere alternative or equivalent to Bukszar's teachings of rendering of an entire web page, not as a teaching away therefrom. Consequently, the Appellants have not shown that the AT&T teaches away from combining teachings of Bukszar therewith.

B. GENERAL ALLEGATIONS REGARDING REFERENCES

1 Just as "[i]t is not the function of [the U.S. Court of Appeals for the Federal Circuit] to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art" *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991), "it is not the function of this Board to examine claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *Ex parte Post*, No. 2005-2042, 2006 WL 1665399 at *4 (BPAI 2006). Furthermore, a "reply by the applicant or patent owner [to a rejection] must . . . distinctly and specifically points out the supposed errors in the examiner's action The reply must present arguments pointing out the specific distinctions believed to render the claims . . . patentable over any applied references." 37 C.F.R. § 1.111(b)(2005).¹ "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the[se] requirements" *Id.*

Here, the Examiner specifically points out where references teach specific limitations recited in the rejected claims. Regarding claims 1 and 3, for example, he makes the following findings.

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

[I]n AT & T, web pages corresponding to links appearing on the web pages entered by the user are retrieved (page 18, lines 5- 26), as in "receiving indicia specifying a subset of said plurality of references" (the "references" in the currently displayed page, where a possible "subset" can simply be all of the links), and "automatically requesting web page data associated with said subset of said plurality of references"

(calling forth the images corresponding to links after accessing further web pages).

(Ans. 6.) The Appellants respond as follows.

The combination of AT&T with Bukszar does not teach or suggest "receiving indicia specifying a subset of said plurality of references," "automatically requesting web page data associated with said subset of said plurality of references," or "rendering additional web pages using said requested web page data in a second panel." Neither AT&T or Bukszar teach or suggest these aspects of the claim. Furthermore, the Examiner fails to address these claim features in the rejection.

(Br. 9.)

Without specifically addressing the Examiner's findings, the Appellants' response amounts to a general allegation that the claims define a patentable invention. It shows no error in the Examiner's findings. Furthermore, the Examiner's specific findings belie the Appellants' assertion that the "Examiner fails to address these claim features in the rejection." (*Id.*) The Appellants make more of such allegations regarding claim 6 (*id.* 13-14); claims 9-11, 14, 15, and 43 (*id.* 15); claim 16 (*id.* 16); claims 17-19 (*id.* 16-17,); claims 47-52 (*id.* 18.); claims 54, 56, and 61 (*id.* 19); and claims 55, 57, 58, and 62. (*Id.* 19-20.) They fail to offer even a general allegation regarding claims 44 and 45, moreover, let alone show error in the Examiner's rejection thereof.

C. GENERAL ALLEGATION REGARDING MOTIVATION

Further regarding claims 17-19, the Examiner specifically explains why it would have been obvious at the time of the invention to a person of ordinary skill in the art to have modified AT&T to arrive at the claimed subject matter. More specifically, he offers the following finding and conclusion.

[I]t would have been still further obvious to the person having ordinary skill in the art at the time of appellant's invention to produce a "three-dimensional" distribution of document objects as per Card to represent the linked "web page" displays as per AT&T/Bukszar, the motivation being to make the information more intuitively accessible to the user, who must comprehend a number of related representations at one time.

(Ans. 10-11.) The Appellants respond, "Other than these assertions, there is no motivation from the references themselves to combine them in the manner suggested by the Examiner." (Br. 17.)

Without specifically addressing the Examiner's finding, the Appellants' response amounts to a general allegation that the claims define a patentable invention. It shows no error in the Examiner's finding.

Furthermore, "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way." *KSR Int'l v.*

Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). A reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Here, based on the premise that teachings from the references themselves must provide an explicit motivation to combine, the Appellants' response is unpersuasive.

D. CONCLUSION

Unpersuaded of error in the Examiner's findings and conclusions, we affirm the obviousness rejections of claims 1, 3, 6, 9-11, 14-19, 43-45, 47-52, 54-58, 61, and 62.

IV. OBVIOUSNESS REJECTIONS OF CLAIMS 4, 5, 7, 8, 20, 21-28, 63, AND 64

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999). In an *ex parte* appeal, instead, the Board of Patent Appeals and Interferences "is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001).

Here, the Examiner admits that AT&T and Bukszar "alone do not extend to the point of obtaining such 'references' from 'a prioritized list' obtained with 'said first web page data', as in claims 4, 5, 7 . . . nor the

sourcing from 'a third party' (claim 8)." (Ans. 11.) He adds the following finding and conclusion.

[I]t would also have been obvious to the person having ordinary skill in the art to link the "web page . . . panel" objects as seen in the AT&T/Bukszar combination by "references" found in places other than the content of the "web page" or user selection, using MacNaughton's technique of INTEGRATING related-but-disparate content. The motivation rests in the type of user environment that each of AT & T and Bukszar are involved with, where anything to assist the user's browsing experience will be a benefit, as in having the additional direction of MacNaughton.

(*Id.* 12.) Neither the finding nor the conclusion, however, addresses the specific limitations of claims 4, 5, 7, 8. For example, the finding and motivation fail to mention the "receiving indicia specifying a subset of said plurality of references comprises receiving said indicia as a prioritized list of references in said first web page data" of claim 4.

Furthermore, although the Examiner purports to include claim 20 in his rejection over AT&T and Bukszar (Ans. 6), his explanation thereof (*id.* at 6-10) fails to mention the claim, let alone address the specific limitations thereof. This failure taints the rejection of claims 21-28, 63, and 64, which depend from claim 20.

The aforementioned omissions persuade us that the rejections of claims 4, 5, 7, 8, 20, 21-28, 63, and 64 are "manifestly not ready for a

decision on the merits." *Braeken*, 54 USPQ2d at 1112. Consequently, we remand the application to the Examiner to address the specific limitations of each of these claims. Any subsequent Examiner's Answer submitted thereby must be self-contained with respect to all rejections and arguments; no prior Answer or Office Action may be referenced or incorporated therein. Similarly, any subsequent Brief submitted by the Appellants must be self-contained with respect to all arguments. No prior Brief may be referenced or incorporated therein.

V. ORDER

In summary, the rejection of claims 1-3, 20, 21, 26-28, 39, and 40 under the judicially-created doctrine of double patenting; the provisional rejection of claims 1-3, 20, 21, 26-28, 39, 40, and 47-53 under the judicially-created doctrine of double patenting; and the rejection of claim 46 under § 112, ¶ 2 are affirmed. The rejections of claims 1, 3, 6, 9-11, 14-19, 43-45, 47-52, 54-58, 61, and 62 under § 103(a) are also affirmed. The rejections of claims 4, 5, 7, 8, 20, 21-28, 63, and 64 under § 103(a), however, are remanded.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmances are based only on the arguments made in the brief. Any arguments or authorities omitted therefrom are neither before us

nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Because it is being remanded for further action, the application is a "special" application. MPEP § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, or reopening prosecution).

AFFIRMED/REMANDED

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Appeal 2008-0394
Application 10/007,207

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